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QM32/0623

EXAMINER

PATTERSON, M

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

06/23/00

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 28

Application Number: 08/873876  
Filing Date: 6/12/97  
Appellant(s): Steven Robbins

\_\_\_\_\_  
Diana DiBerardino  
For Appellant

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed 5/19/00.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

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The brief contains a statement identifying that there are no related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

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4,633,877

PENDERGAST

1-1987

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

The specification is objected to under 37 CFR 1.71 and 35 USC 112, first paragraph because it fails to adequately teach how to make and/or use the invention, i.e. fails to provide an enabling disclosure.

Applicant has provided a single example of a material which would work, this example has a "resiliency index" of 0.156 and a Shore A hardness of A5. It is not clear how applicant assumes that a material with a "resiliency index" in the entire range of 0.05-0.5 would work or for the Shore A hardness range of A2-A40, preferably A2-A14, since the only material disclosed has an index of 0.156 and A5 and according to the Declaration filed 5/8/98 applicant has found only one other material in the stated range which has an index of 0.218. Since applicant has stated that the other commonly used shoe materials have an index above 0.6, there is no clear evidence of why applicant contends or assumes that an index of 0.5, 0.4 or 0.3 would be appropriate. It is not clear how or why a measurement of almost 3 times the index of the material applicant has found would be considered appropriate.

***Claim Rejections - 35 USC § 112***

- I.** Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See above objection to the specification.

2. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-3 and 9-11 the phrase "resiliency index....." is vague and indefinite because it is not clear what materials applicant intends to encompass with such language. Especially since it appears that applicant has only been able to find two materials which fit into the categories claimed.

***Claim Rejections - 35 USC § 102***

3. Claims 1-3, 7-11, and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Pendergast.

Pendergast shows a sole made from PVC foam with a Shore A hardness of 5A-50A and suggests selecting a particular hardness of firmness based upon the stretch, contraction, and dwell desired and that the materials will exhibit the characteristic of impact absorption and compression (in contrast with resilience) (column 8 lines 59-69). The materials used and suggested by Pendergast inherently would have resiliency indexes as claimed.

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***Claim Rejections - 35 USC § 103***

4. Claims 4-6 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pendergast.

Pendergast as discussed above shows a shoe sole substantially as claimed except for the exact thickness of the sole. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the sole a thickness of between 12mm and 20mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

***(11) Response to Argument***

In response to applicants' arguments that the specification clearly teaches how a resiliency index can be measured and one material which is considered to be appropriate, the specification does not provide basis for the range of 0.05-0.5. In response to applicants' argument that all indicies below 0.6 are good, does not give basis for the claimed range of 0.05-0.5. There is no basis as to how such a range is considered to be optimum. It appears that applicant has merely arbitrarily selected such a range without any basis for such. Especially, when the only materials which applicant has tested which have resiliency indexes in the range are nowhere near the end parameters of the range. The fact that applicant argues that cure time, temperature, pressure, and aeration of a foam affects the resiliency index and that no material has an inherent resiliency index

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also further reinforces the Examiners basis for the lack of disclosure and lack of clarity as to what materials are intended to be encompassed by applicants claims and specification.

In response to applicants' arguments directed towards the 112 second paragraph rejection, the claims have been rejected because it is not clear what materials have such a property especially in view of applicants new arguments that no material has an inherent resiliency index because it is dependent on cure time, temperature, pressure, and aeration in addition of the Shore A hardness. It is not clear what materials applicant intends to encompass with such language. It appears that applicant has arbitrarily made up a formula and has arbitrarily selected a range of values obtained by the formula and there is no way to know what materials would fall into such a range without specifically performing applicants test at a particular time, temperature, pressure, etc. and therefore it is not clear what materials are intended to be encompassed.

In response to applicants' arguments directed towards Pendergast, Pendergast clearly discloses the use of PVC foam with a shore A hardness of 5A and furthermore teaches selecting such foam based on desired hardness of firmness based on stretch, contraction, and dwell desired. The fact that there may be many PVC foams which result in a resiliency index which does not fall into the claimed range does not negate the fact that such a disclosure clearly and inherently encompasses PVC foams which would fall into the claimed resiliency index range. Especially since applicant has stated that a PVC foam with a shore A hardness of A5 does fall in the range.

In response to applicants' argument that the prior art does not address the problem of balance and stability, it is not an invention to perceive that the product which others had discovered had


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qualities they failed to detect. (National Distillers and Chemical Corporation v. Brenner, 156 USPQ 163, 854 OF 844).

In response to applicants' Declaration filed under 37 CFR 1.132, the fact that applicant has tested numerous more PVC foams which do not have resiliency indexes within the claimed range does not negate the fact that there are PVC foams which do have resiliency indexes within the claimed range.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



**M.D. Patterson**  
Primary Examiner

MDP  
June 21, 2000

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